

the Claims to overcome all deficiencies noted in the Examiner's Office Action. After entry of this Amendment Claims 1, 3 – 8 and 18 - 27 remain in the Application.

**In the Office Action the Examiner stated that new drawings are required contingent upon allowance.**

Applicants will timely file revised formal drawings after allowable subject matter is identified in the Application.

**Continuing in the Office Action, the Examiner made the restriction requirement final that was made earlier in the prosecution of the Application.**

**The Examiner continued in the Office Action, rejecting Claims 18 – 20 under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicants regard as the invention. According to the Examiner, by providing a providing means, it is indefinite whether the providing means provides itself.**

Applicants have amended Claims 18 – 20 to avoid claiming "...providing a providing means...". Accordingly, Applicants believe that the Examiner's rejection of Claims 18 - 20 under 35 U.S.C. 112, second paragraph, is overcome in amended Claims 18 – 20. Applicants respectfully request that the Examiner withdraw his objection of Claims 18 – 20 under 35 U.S.C. 112, second paragraph.

**The Examiner continued in the Office Action, rejecting Claims 1 – 6 and 18 – 20 under 35 U.S.C. 102(e) as being anticipated by Hamm et al. (U.S. Patent No.**

**6,182,857; hereinafter referred to as "Hamm"). According to the Examiner, Hamm discloses:**

**(re: Claim 1) apparatus for delivering a companion device with delivery of a product apparatus (Col. 3, lines 15 – 17, art supplies with paper) comprising:  
control means for controlling dispensing (12);  
actuator coupled to control means (24);  
link for effecting cooperation (28; FIG. 1).**

**(re: Claim 2) companion means includes a dispensing means (82).**

**(re: Claim 3) communication means for communicating (Col. 3, lines 37 – 52);  
memory means for storing operational information.**

**(re: Claim 4) communication means comprises a telephone connection with a remote controlling station (Co. 3, lines 37 – 52).**

**(re: Claim 5) communication means comprises an input access port for providing control by an operator (FIG. 3).**

**(re: Claim 6) communications system comprises a satellite communication connection with a remote controlling station (Col. 4, lines 15 – 19).**

**(re: Claim 18) method for providing at least one item of value from an apparatus in cooperation with operation of a companion device comprising providing a control means for controlling a providing (12); providing a providing means (Col. 7, lines 27 – 43); providing a link for effecting cooperation (28).**

**(re: Claim 19) communication means coupled with apparatus for communicating operation information with apparatus regarding operation of apparatus (232/234 & 244);**

**providing a memory means for storing operational information.**

**(re: Claim 20) communicating a directive comprising a change from a remote locus (Col. 16, lines 40 – 67).**

Applicants respectfully traverse the Examiner's rejection of Claims 1 – 6 and 18 – 20 under 35 U.S.C. 102(e) as being anticipated by Hamm. Hamm discloses an integrated product supply network consisting of intelligent vending or dispensing machines linked through a computer network to the entire channel of distribution for particular products. Hamm's intelligent vending or dispensing machines include an improved product discharge mechanism allowing the machine to accommodate a variety of products.

[Hamm; Col. 1, lines 8 – 13]

Hamm's disclosure of dispensing art supplies with paper is not a disclosure of dispensing at least one indicium of value substantially contemporaneously with delivering a product (as now claimed in amended Claims 1, 3 – 8, 18 – 20 and new Claims 21 – 27). Rather Hamm is there simply disclosing his novel dispensing mechanism. [Hamm; Col. 2, lines 15 – 17]

The apparatus of the present invention is now explicitly claimed as being attached with the companion device. Hamm discloses no attachment between his vending machine (companion device) and another apparatus with which the vending machine cooperates to substantially contemporaneously dispense a product and at least one indicium of value. Hamm merely discloses an internet connection (or other communication network arrangement) between a CPU 12 and vending machines 24. [Hamm; FIG. 1] The control means of the present invention is part of the apparatus which is attached to the companion device. Hamm's integrated product supply network cannot be fairly read to anticipate or in any way disclose an apparatus that includes a control means, which apparatus is attached with a companion device and cooperates with that attached companion device to substantially contemporaneously dispense at least one indicium of value and a product. Further, Hamm's integrated product supply network cannot be fairly read to anticipate or in any way disclose a method for dispensing at least one indicium of value from an apparatus in cooperation with an attached companion device for delivering at least one product to a user substantially contemporaneously with the dispensing. Hamm does not teach, disclose, show, suggest, or in any way render obvious the apparatus or method of the invention as presently claimed in amended independent Claims 1 and 18. New independent Claim 21 specifically claims that the apparatus and the companion device are assembled in a unitary configuration. Hamm does not teach, disclose, show, suggest, or in any way render obvious the apparatus or method of the invention as presently claimed in Claim 21. Claims 3 – 8, 19 – 20 and 22 - 27 depend from allowable claims and are, therefore, themselves allowable.

**The Examiner continued in the Office Action, rejecting Claims 1 – 5, 7 – 8 and 18 – 20 under 35 U.S.C. 102 (b) as being anticipated by Rivalto (US. Patent No 5,482,139). According to the Examiner, Rivalto discloses:**

**(re: Claim 1) apparatus for delivering a companion device with delivery of a product apparatus comprising:**

**control means for controlling dispensing (102: FIG. 2);**

**actuator coupled to control means (20);  
link for effecting cooperation (Col. 3, lines 1 – 7).**

**(re: Claim 2) companion means includes a dispensing means (24).**

**(re: Claim 3) communications means for communicating (Col. 3, lines 1 – 7);  
memory means for storing operational information (14).**

**(re: Claim 4) communication means comprises a telephone connection with a  
remote controlling station (Col. 3, lines 1 – 7).**

**(re: Claim 5) communication means comprises an input access port for  
providing control by an operator (18).**

**(re: Claim 7) at least one item of value comprises a coupon redeemable for at  
least one second product (24).**

**(re: Claim 8) at least one item comprises a product sample (Col. 7, lines 1 –  
3).**

**(re: Claim 18) method for providing at least one item of value from an  
apparatus in cooperation with operation of a companion device comprising  
providing a control means for controlling a providing (Col. 4, lines 38 -55);  
providing a providing means (Col. 4, lines 38 – 55);  
providing a link for effecting cooperation (Col. 4, lines 38 – 55).**

**(re: Claim 19) communication means coupled with apparatus for communicating operation information with apparatus regarding operation of apparatus (Col. 4, line 38 - 55); providing a memory means for storing operational information (Col. 4, line 56 – Col. 5, line 7; 110).**

**(re: Claim 20) communicating a directive comprising a change from a remote locus (Col. 6, lines 10 – 27).**

Applicants respectfully traverse the Examiner's rejection of Claims 1 – 5, 7 – 8 and 18 – 20 under 35 U.S.C. 102 (b) as being anticipated by Rivalto. Rivalto discloses an automated drive-up retail facility for vending or distributing consumer products. [Rivalto; Col. 1, lines 7 – 10] Rivalto describes first and second sets of predetermined product promotional criteria that are designed to promote designated products prior to the customer ending the vending transaction (emphasis provided). [Rivalto; Col. 3, lines 47 – 50] Rivalto describes examples of such arrangements as including dispensing discount savings coupons or free product samples to the customer prior to the selecting of products (emphasis provided) [Rivalto; Col. 3, lines 51 – 52] and activating predetermined audio or video advertising to the customer while they are shopping (emphasis added) [Rivalto; Col. 3, lines 53 – 54].

Rivalto cannot be fairly read to anticipate or render obvious the present invention because to do so completely counters the stated purpose and operation of Rivalto's disclosed automated drive up vending facility. Specifically, Rivalto offers coupons or samples or other items to a customer prior to the customer ending the vending transaction in an effort to entice the customer to extend the vending transaction and purchase additional items. Rivalto does not disclose dispensing coupons or other enticements substantially

contemporaneously with delivering a product. Rivalto specifically dispenses and, in fact must dispense his enticements prior to the end of the vending transaction because he is seeking to extend the vending transaction. If Rivalto dispensed his enticements substantially contemporaneously with the delivery of products, he would assuredly miss his opportunity to exercise his enticements to achieve their purpose – his enticements would be too late, the vending transaction is completed when the products are delivered. Thus, Rivalto teaches away from an apparatus is attached with a companion device and cooperates with that attached companion device to substantially contemporaneously dispense at least one indicium of value and a product. Further, Rivalto teaches away from a method dispensing at least one indicium of value from an apparatus in cooperation with an attached companion device for delivering at least one product to a user substantially contemporaneously with the dispensing.

Moreover, Rivalto discloses no attachment between a vending machine (companion device) and an apparatus with which the vending machine cooperates to substantially contemporaneously dispense a product and at least one indicium of value.

The Examiner cites a discussion by Rivalto regarding participation by an attendant in the vending transaction in verification of acceptable customer identification (Rivalto; Col. 3, lines 1 – 7; cited by the Examiner) as anticipating Applicants' link for effecting cooperation (Claim 1), as anticipating Applicants' communication means (Claim 3) and as anticipating Applicants' communication means comprising a telephone connection with a remote controlling station (Claim 4). Applicants respectfully submit that a human attendant cannot fairly be cited as anticipating an element of an invention. Applicants further respectfully submit that the Examiner cannot fairly cite the same human attendant as anticipating three separate elements of an invention. Rivalto does not disclose an apparatus that includes a control means, which apparatus is attached with a companion device and cooperates with that attached companion device to substantially contemporaneously dispense at least one indicium of value and a product.

Rivalto's automated drive up vending facility cannot be fairly read to anticipate or in any way disclose an apparatus that includes a control means, which apparatus is attached with a companion device and cooperates with that attached companion device to substantially contemporaneously dispense at least one indicium of value and a product. Rivalto does not teach, disclose, show, suggest, or in any way render obvious the invention as presently claimed in amended independent Claims 1 and 18. New independent Claim 21 specifically claims that the apparatus and the companion device are assembled in a unitary configuration. Rivalto does not teach, disclose, show, suggest, or in any way render obvious the apparatus or method of the invention as presently claimed in Claim 21. Claims 3 – 8, 19 – 20 and 22 - 27 depend from allowable claims and are therefore, themselves allowable.

**The Examiner continued in the Office Action, rejecting Claims 1 – 6, 8 and 18 – 20 under 35 U.S.C. 103(a) as being unpatentable over Hamm in view of LaDue (U.S. Patent No. 6,292,711) in which Hamm discloses the elements previously discussed and LaDue discloses the elements not inherently disclosed by Hamm of:**

**(re: Claim 7) at least one item of value comprises a coupon redeemable for at least one second product (Col. 1, line 45). According to the Examiner it would have been obvious at the time of the invention for Hamm to dispense a coupon because related product use may be encouraged as taught by LaDue and come up with the instant invention.**

Applicants respectfully traverse the Examiner's rejection of Claims 1 – 6, 8 and 18 – 20 under 35 U.S.C. 103(a) as being unpatentable over Hamm in view of LaDue. LaDue contributes nothing to render Claims 1, 18 or 21 (the independent claims in the Application) unpatentable. Further, there is no suggestion in either Hamm or in LaDue to combine Hamm and LaDue. Clearly no impetus is present for combining Hamm and LaDue because Hamm and LaDue are not classified in the same Class. Further, Hamm and LaDue have no Classes in common in their cross reference filing classifications. Still

further, Hamm and LaDue have no Classes in common in their respective Fields of Search. Claim 7 depends from an allowable claim and is, therefore, itself allowable. Neither Hamm nor LaDue nor any combination of Hamm and LaDue teaches, shows, discloses, suggests or in any way renders obvious the invention presently claimed in amended independent Claims 1 and 18 and new independent Claim 21. Claims 3 – 8, 19 – 20 and 22 - 27 depend from allowable claims and are therefore, themselves allowable.

**The Examiner continued in the Office Action, rejecting Claims 1 – 8 and 18 – 20 under 35 U.S.C. 103(a) as being unpatentable over Rivalto in view of Comer et al. (U.S. Patent No. 5,596,501; hereinafter referred to as “Comer”) in which Rivalto discloses the previously discussed and Comer discloses the elements not inherently disclosed by Rivalto:**

**(re: Claim 6) communications system comprises a satellite communication connection with a remote controlling station (FIG. 1). According to the Examiner, it would have been obvious at the time of the invention to include a satellite communication link because a satellite link may facilitate communication remote locations in (sic, in which) wiring is impractical as taught by Comer and thereby come up with the instant invention.**

Applicants respectfully traverse the Examiner’s rejection of Claims 1 – 8 and 18 – 20 under 35 U.S.C. 103(a) as being unpatentable over Rivalto in view of Comer. Comer contributes nothing to render Claims 1, 18 or 21 (the independent claims in the Application) unpatentable. Further, there is no suggestion in either Rivalto or in Comer to combine Rivalto and Comer. Clearly no impetus is present for combining Rivalto and Comer because Rivalto and Comer are not classified in the same Class. Further, Rivalto and Comer have no Classes in common in their cross reference filing classifications. Still further, Rivalto and Comer have no Classes in common in their respective Fields of Search. In fact, it is worthy of note that none of Hamm, Rivalto, LaDue and Comer have any common Classes among their respective classifications, their respective cross

reference classes or their respective Fields of Search. Claim 6 depends from an allowable claim and is, therefore, itself allowable. Neither Rivalto nor Comer nor any combination of Rivalto and Comer teaches, shows, discloses, suggests or in any way renders obvious the invention presently claimed in amended independent Claims 1 and 18 and new independent Claim 21. Claims 3 – 8, 19 – 20 and 22 - 27 depend from allowable claims and are therefore, themselves allowable.

Applicants have reviewed the other art of record (20 patent references) cited by the Examiner. Applicants respectfully submit that none of the art of record individually, or in any combination, teaches, shows, discloses, suggests or in any way renders obvious the invention presently claimed in amended independent Claims 1 and 18 and new independent Claim 21. Claims 3 – 8, 19 – 20 and 22 - 27 depend from allowable claims and are therefore, themselves allowable.

Since Applicants have fully and completely responded to the Official Action, this Application is now in order for early action and such early action is respectfully requested. If the Examiner would deem a telephone conference to be of value in expediting this Application, he is invited to call the undersigned attorney at (972) 758-1955 at his convenience.

Respectfully submitted,



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Washington, D.C. 20231



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VERSION WITH MARKINGS TO SHOW CHANGES MADEIn the Claims:

Claim 2 has been canceled.

Claims 1, 3 – 8 and 18 – 20 have been amended as follows:

1. (Amended) An apparatus for [providing] dispensing at least one [item] indicium of value in cooperation with operation of [a] an attached companion device[; said companion device] for delivering at least one first product to a user substantially contemporaneously with said dispensing; the apparatus comprising:

- (d) a control means for controlling said [providing] dispensing;
- (e) a providing means for effecting said [providing] dispensing; said providing means being coupled with said control means; and
- (f) a link [with] between the apparatus and said companion device for effecting said cooperation.

3. (Amended) An apparatus for [providing] dispensing [items] at least one indicium of value in cooperation with operation of [a] an attached companion device as recited in Claim 1 wherein the apparatus further comprises:

- (f) a communication means coupled with said control means for communicating operational information with the apparatus regarding operation of the apparatus; and
- (g) a memory means coupled with said communication means for storing said operational information.

4. (Amended) An apparatus for [providing] dispensing [items] at least one indicium of value in cooperation with operation of [a] an attached companion device as recited in

Claim 3 wherein said communication means comprises a telephone connection with a remote controlling station

5. (Amended) An apparatus for [providing] dispensing [items] at least one indicium of value in cooperation with operation of [a] an attached companion device as recited in Claim 3 wherein said communication means comprises an [input] access port for providing control access by an operator effecting a connection with the apparatus via said access port.

6. (Amended) An apparatus for [providing] dispensing [items] at least one indicium of value in cooperation with operation of [a] an attached companion device as recited in Claim 3 wherein said communication means comprises a satellite communication connection with a remote controlling station.

7. (Amended) An apparatus for [providing] dispensing [items] at least one indicium of value in cooperation with operation of [a] an attached companion device as recited in Claim [2] 3 through 6 wherein said at least one [item] indicium of value comprises a coupon; said coupon being redeemable for at least one second product.

8. (Amended) An apparatus for [providing] dispensing [items] at least one indicium of value in cooperation with operation of [a] an attached companion device as recited in Claim [2] 3 through 6 wherein said at least one [item] indicium of value comprises a product sample.

18. (Amended) A method for [providing] dispensing at least one [item] indicium of value from an apparatus in cooperation with operation of [a] an attached companion device[ ; said companion device] for delivering at least one first product to a user substantially contemporaneously with said dispensing; the method comprising the steps of:

- (a) providing a control means for controlling said [providing] dispensing;
- (b) providing a [providing] means coupled with said control means for effecting said [providing] dispensing; [said providing means being coupled with said control means;] and
- (c) providing a link [with] between the apparatus and said companion device for effecting said cooperation.

19. (Amended) A method for [providing] dispensing at least one [item] indicium of value from an apparatus in cooperation with operation of [a] an attached companion device as recited in Claim 18 wherein the method comprises the further step of:

- (d) providing a communication means coupled with the apparatus for communicating operational information with the apparatus regarding operation of the apparatus; and
- (e) providing a memory means coupled with said communication means for storing said operational information.

20. (Amended) A method for [providing] dispensing at least one [item] indicium of value from an apparatus in cooperation with operation of [a] an attached companion device as recited in Claim 19 wherein the method comprises the further step of:

- (f) communicating at least one directive with the apparatus from a locus remote from the apparatus; said directive effecting a change regarding said at least one [item] indicium of value.

New Claims 21 - 27 have been added as follows:

21. An apparatus for dispensing at least one indicium of value in cooperation with operation of a companion device; said companion device and the apparatus being assembled in a unitary configuration for delivering at least one first product to a user substantially contemporaneously with said dispensing; the apparatus comprising:

- (a) a control means for controlling said dispensing;
- (b) a providing means coupled with said control means for effecting said dispensing; and
- (c) a link between the apparatus and said companion device for effecting said cooperation.

22. An apparatus for dispensing at least one indicium of value in cooperation with operation of a companion device as recited in Claim 21 wherein the apparatus further comprises:

- (d) a communication means coupled with said control means for communicating operational information with the apparatus from outside the apparatus regarding operation of the apparatus; and
- (e) a memory means coupled with said communication means for storing said operational information.

23. An apparatus for dispensing at least one indicium of value in cooperation with operation of a companion device in Claim 22 wherein said communication means comprises a telephone connection with a remote controlling station

24. An apparatus for dispensing at least one indicium of value in cooperation with operation of a companion device in Claim 22 wherein said communication means comprises an access port for providing control access by an operator effecting a connection with the apparatus via said access port.
25. An apparatus for dispensing at least one indicium of value in cooperation with operation of a companion device in Claim 22 wherein said communication means comprises a satellite communication connection with a remote controlling station.
26. An apparatus for dispensing at least one indicium of value in cooperation with operation of a companion device in Claim 22 through 25 wherein said at least one indicium of value comprises a coupon; said coupon being redeemable for at least one second product.
27. An apparatus for dispensing at least one indicium of value in cooperation with operation of a companion device in Claim 22 through 25 wherein said at least one indicium of value comprises a product sample.